REMARKS

Claims 1-53 were originally presented in the subject application. No claims have herein been amended, added or canceled. Therefore, claims 1-53 remain in this case.

Applicant respectfully requests reconsideration and withdrawal of the grounds of rejection.

35 U.S.C. §102 Rejection

The Office Action rejected claims 1, 2, 5-7, 14-18, 20, 21, 24, 25, 37, 38, 41, 42 and 49-53 under 35 U.S.C. §102(e), as allegedly anticipated by Ellenby et al. (U.S. Patent No. 6,307,556). Applicant respectfully, but most strenuously, traverses this rejection.

With respect to the anticipation rejection, it is well settled that a claimed invention is not anticipated unless a single prior art reference discloses: (1) all the same elements of the claimed invention; (2) found in the same situation as the claimed invention; (3) united in the same way as the claimed invention; (4) in order to perform the identical function of the claimed invention. In this instance, Ellenby et al. fails to disclose multiple elements of each of the independent claims and as a result does not anticipate, or even render obvious, Applicant's claimed invention.

Claim 1 recites, for example, acquiring by the first computing unit a digital elevation model of the scene, wherein the digital elevation model is based on elevation data corresponding to information about the scene. As noted in the present application at page 5, lines 21-26, a digital elevation model is three-dimensional digital data about a scene used to create a three-dimensional perspective model of the scene in two dimensions. Thus, the phrase "digital elevation model" has meaning in the art.

Against this aspect of claim 1, the Office Action cites to Ellenby et al. at column 7, lines 25-46 and FIG. 9 therein. The cited sections of Ellenby et al. merely disclose overlaying information about aspects of the scene, such as the name of a mountain in the

scene and its elevation. However, there is no disclosure, teaching or suggestion of a digital elevation model, which is something quite different from the elevation of a mountain.

As another example, claim 1 recites registering by the first computing unit the digital image of the scene with the digital elevation model to create a registered digital image. Registering is described in the present application at page 6, lines 1-4. Effectively, registering refers to lining up the image and elevation model such that the same point has the same coordinates in both, allowing for some inherent alignment error. Thus, the term "registering" also has meaning.

Against this aspect of claim 1, the Office Action cites to FIG. 9 of Ellenby et al. As an initial matter, however, since Ellenby et al. fails to disclose, teach or suggest a digital elevation model, Applicant submits that it also cannot disclose, teach or suggest registering the same with anything. Moreover, FIG. 9 in and of itself shows only data about the scene overlaid on the scene, which does not even suggest registering with anything, let alone a digital elevation model. All one needs to know are horizontal and vertical camera angles to use photogrammetric methods to determine the distance of an observer to a point appearing in two cameras' fields of view, for example. In addition, Ellenby et al. discloses adding the name of the mountain in the scene of FIG. 9, but gives no information on how identifying the mountain would be accomplished. Presumably, then, Ellenby et al. must refer to manually recognizing the mountain and overlaying that information on the scene. Finally, if the observation elevation is known, the relative elevation can easily be calculated. Indeed, that is what is disclosed in column 7 of Ellenby et al. describing FIG. 9.

The Office Action alleges that registering the image is inherent in Ellenby et al., in order to effect augmenting the different images into one composite image.

As an initial matter, Applicant wishes to clear up apparent confusion as to what is meant in Ellenby et al. by "composite image." Applicant has carefully reviewed Ellenby et al. and find that a composite image as used therein refers generally to an image with non-image information overlayed on the image, and not a composite image of multiple images.

For example, in FIG. 8 of Ellenby et al., element 84 is an icon, and FIGs. 9-12 all show textual information overlayed on the image.

Returning to the issue of whether registering is inherent in Ellenby et al, it is also important to point out that claim 1 recites not simply registering in general, but registering a digital image of a scene with a digital elevation model for that scene.

The doctrine of inherency is well-settled in patent law, and is best described in an excerpt from *Hansgirg v. Kemmer*, 26 C.C.P.A. 937, 102 F.2d 212, 40 U.S.P.Q. 665 (1939):

> Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [citations omitted.] If, however, the disclosure [of the cited reference] is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient [to anticipate the claimed invention].

Id. at 940, 102 F.2d at 214, 40 U.S.P.Q. at 667; *Stoller v. Ford Motor Co.*, 18 U.S.P.Q.2d 1545, 1547 (Fed. Cir. 1991); *Tyler Refrigeration v. Kysor Industrial Corporation*, 227 U.S.P.Q. 845, 847 (Fed. Cir. 1985); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990); *In re Oelrich and Divigard*, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).

In *Ex parte Levy*, the court stated that "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 U.S.P.Q.2d at 1464 (lengthy citation omitted) (underlining added).

Applicant submits that the Office Action fails to provide the required basis in fact and/or technical reasoning showing that registering a digital image of a scene with a digital elevation model of that scene necessarily flows from Ellenby et al. What the Office Action alleges is that there must be *some* type of registering or tagging going on in Ellenby et al., in

order to augment the image. However, it has already been shown above that all the specific examples of overlaying in Ellenby et al., including distance and height measurements, can be achieved manually, and in the absence of any disclosure otherwise (which is the case in Ellenby et al.), Applicant submits that is all that can fairly be assumed. To do anything else would be unfairly attributing a teaching to Ellenby et al. that simply is not there. Indeed, the Office Action itself admits that Ellenby et al. does not explicitly teach registering the image.

Thus, Applicant submits that Ellenby et al. does not inherently disclose registering a digital image of a scene with a digital elevation model of that scene.

As yet another example, claim 1 recites providing the registered digital image from the first computing unit to a second computing unit coupled to the first computing unit by a communications network.

Against this aspect of claim 1, the Office Action cites to column 3, lines 14-46 of Ellenby et al. However, the cited section, as well as the remainder of Ellenby et al., actually discloses sending information from one vision system to another, with that information being information about the scene and not the scene itself. For example, Ellenby et al. discloses sending information about a duck in one view so that textual information about the duck siting can be added to the view of the other system. Nowhere does Ellenby et al. disclose, teach or suggest sending an image from one vision system to another, only information about the scene for overlaying on the scene in another vision system. Moreover, on an even more basic level, since Ellenby et al. fails to disclose, teach or suggest registering a digital image with a digital elevation model, Applicant submits it cannot disclose, teach or suggest doing anything with the registered digital image resulting therefrom, let alone specifically sending it from one computing unit to another coupled by a communications network.

As still another example, claim 1 recites augmenting the registered digital image provided to the second computing unit with at least some of the information about the scene in response to input from the second computing unit.

Against this aspect of claim 1, the Office Action cites to Ellenby et al. at column 3, lines 26-37. However, Ellenby et al. discloses two vision systems, with information about the scene at one vision system being used at the second for overlaying on the scene at the second. There is no disclosure, teaching or suggestion of augmenting an image at a second computing unit that was provided to the second computing unit from a first computing unit. There is also no disclosure, teaching or suggestion of a digital image registered with a digital elevation model, nor augmenting in response to input from the second computing unit.

Therefore, for all the reasons noted above, Applicant submits that claim 1 cannot be anticipated by, or made obvious over, Ellenby et al.

Independent claims 20 and 37 contain limitations similar to those noted above with respect to claim 1. Thus, the arguments above with respect to claim 1 are equally applicable to claims 20 and 37. Therefore, claims 20 and 37 also cannot be anticipated by, or made obvious over, Ellenby et al.

CONCLUSION

Applicant submits that the dependent claims not specifically addressed herein are allowable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their additional limitations.

For all the above reasons, Applicant maintains that the claims of the subject application define patentable subject matter and earnestly requests allowance of claims 1-53.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicant's undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,

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